



TFW

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Doris HUBLER et al.

Examiner: WEBMAN, Edward J.

Serial No.: 09/719,221

Group Art Unit: 1616

Filed: February 16, 2001

Title: PHARMACEUTICAL COMBINATION USED TO COMPENSATE FOR A
TESTOSTERONE DEFICIENCY WHILE PROTECTING THE PROSTATE

REPLY

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

SIR:

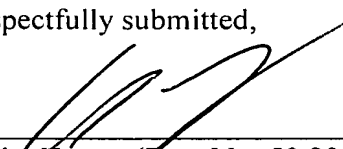
In response to the Office Action mailed on May 8, 2006, please consider the following.

Claims 33, 45, 39-42, 46, 53-54 and 57-60 are rejected as allegedly unpatentable over Hesch in view of Neri. Hesch teaches that BPH has a course parallel with testosterone deficiency (see column 1, lines 10-60) and that testosterone based compounds can be used to treat PBH (see column 7, lines 35-37). Nowhere does Hesch teach or suggest that BPH can be prevented (prophylaxis). Neri also does not teach prevention of BPH, but only treatment and control thereof. See column 1, lines 16 and 22-23, and column 2, lines 10-12, 15-16 and 22. Moreover, the Office Action also alleges that Neri teaches treatment of BPH. However, claim 33 and its dependents are rejected which recite the prophylaxis of BPH. Since neither reference teaches or suggests the prophylaxis of BPH, these references do not render the rejected claims obvious.

Reconsideration is respectfully requested.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,



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